

REMARKS

Prior to entry of this paper, Claims 1-25 and 28-29 were pending. Claims 1-25 and 28-29 were rejected. In this paper, Claim 9 and 14 are amended to correct clerical errors; these are cosmetic amendments that do not affect the scope of the Claims. Claim 21 is amended in an identical manner as in the previous amendment; the amendment to Claim 21 is repeated herein since the previous amendment was not entered. Claims 1-25 and 28-29 are currently pending. In this paper, whenever language is quoted from a claim that has been amended with regard to the portion of the claim quoted, the quoted claim language is that of the claim as amended. No new matter is added by way of this amendment. For at least the following reasons, Applicants respectfully submit that each of the presently pending claims is in condition for allowance.

Claim Objections (Claims 1 and 14)

Claim 1 was objected to as the recitation “the application” lacking antecedent basis. The objection is respectfully traversed.

The recitation “the application that is associated with the at least one archive that is associated with the e-mail address” in Claim 1 has antecedent basis in the recitation “each of the at least one archive of e-mails being based on a different application from a first application used to initiate the searching” of Claim 1. The recitation “each of the at least one archive of e-mails being based on a different application from a first application used to initiate the searching” establishes that each archive of e-mails is associated with an application. Therefore, any of the archives of e-mails has an application that is associated with the archive. Therefore, “the application that is associated with the at least one archive that is associated with the e-mail address” has appropriate antecedent basis.

Claim 14 was objected to as the recitations “the organization folder” and “the electronic addresses book” lacking antecedent basis. It is respectfully submitted that these objections to Claim 14 are moot.

Rejections under 35 U.S.C. § 101 (Claims 16-17)

Claim 16-17 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The rejection is respectfully traversed.

First, Claim 16 specifically recites, “An apparatus”. “An apparatus” is one of the four statutory classes. Even assuming *arguendo* that the various “means” recited in Claim 16 could be construed as software *per se*, absent the recitation “An apparatus”, the fact the claim specifically recites “An apparatus” removes the possibility that Claim 16 is claiming software *per se*; rather, it requires that the subject matter of Claim 16 be an apparatus.

Additionally, the Claim 16 includes elements such as “means for filtering configured to receives the at least one e-mail address”, “means for adding configured to add the at least one email address to the address book”, and “means for scanning ... configured to search one or more archives for at least one email address”. Software *per se* cannot receive an email address, add an email address to an address book, or search for an email address. Software cannot possibly do these things if it is not embodied on a computer readable media. Software is not configured to receive an email address, configured to perform a search, or configured to search for an email address, unless it is embodied on a computer-readable media in such a way that it can actually perform those functions. Software pseudo code written on a piece of paper that is directed toward performing a search is not “configured to perform a search”.

Further, the Office Action dated August 8, 2008 [Office Action] states, “in view of specification, Examiner does not find the physical **recital of structure** as a means of step for performing the specified function” (emphasis in original). However, the physical recital of structure was specifically pointed out in the last response, and partially quoted by the Examiner in the last Office Action. It is unclear why the Examiner does not view a system including one or more processors, which includes the software within computer memory including program code executable by one or more processors, as not being a physical recital of structure. Moreover, as stated above, the various “means” would have to be embodied on a computer-readable medium in order to actually be **configured** to perform functions such as “search one or more archives for at least one email address”. Software *per se* cannot possibly be configured to search for at least one email address until it is actually embodied on a computer-readable medium.

For at least these reasons, it is respectfully submitted that the rejections to Claims 16 and 17 under 35 U.S.C. § 101 should be withdrawn, and notice to that effect is earnestly solicited.

Discussion of Comments in Advisory Action regarding 35 U.S.C. § 101

The Advisory Action dated September 11, 2008 [Advisory Action] stated, "... should be a physical recital of structure. However, 'a system...processor.. memory...' are not recited in the rejected claim." A means plus function claim under 35 U.S.C. § 112, paragraph 6 should **not** recite physical structure. Applicant responded to the statement to the Office action, "in view of **specification**, Examiner does not find the physical **recital of structure** as a means of step for performing the specified function" (emphasis on "recital of structure" in original, emphasis on "specification" added). Applicant was pointing out the recital of structure in the specification. As a means plus function claim, a physical recital of structure should not be made, even for a claim to an apparatus. However, lack of physical recital of structure in an apparatus claim that is a means plus function recitation under 35 U.S.C. 112, paragraph 6 is still an apparatus claim even though the claim itself does not include a physical recital of structure.

Rejections under 35 U.S.C. § 103 (Claims 1-25 and 28-29)

Claims 1-6 and 9-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tafoya et al. (US Patent 6,952,805, hereinafter "Tafoya") in view of Huang (US Patent Publication 2003/0231207, hereinafter "Huang"). Claim 7 was rejected under 35 U.S.C. 103(a) as being unpatentable over Tafoya and Huang as applied to claim 1 above, and further in view of Cresswell et al. (U.S. Patent 6,564,264, hereinafter "Cresswell"). Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Tafoya and Huang as applied to claim 6 above, and further in view of Harms et al. (U.S. Patent Publication 2003/0078981, hereinafter "Harms"). Claims 28-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Que ("**Special Edition Using Microsoft Outlook 2002**", Publisher Que, June, 2001) in view of Tafoya et al., and further in view of Huang. Each of these rejections is respectfully traversed.

First, Claim 1 is respectfully submitted to be allowable at least because neither Tafoya nor Huang, singly or in combination, discloses or teaches the recitation, "the e-mail address is added to

a folder within the electronic address book, such that the folder is with the application that is associated with the at least one archive that is associated with the e-mail address”, as recited in Applicants’ Claim 1.

The Office Action states, “Tafoya discloses wherein the e-mail address is added to a folder within the electronic address book (col. 7, lines 36-54, col. 11, lines 51-54, col. 12, lines 60-61).”

The sections that the Office refers to make it unclear whether the Office intends that the folders such as “inbox” and “sent items” of Tafoya is viewed as being the recited folders within the electronic address, or whether the Office views the “resolution list” of Tafoya as the recited electronic address book. Column 7, lines 36-54 of Tafoya have to do with folders such as “inbox” and “sent item”. Column 11, lines 51-54 and column 12, lines 60-61 of Tafoya have to do with the resolution list.

If the Office is using folders such as “inbox” and “sent items” as the recited folders within the address book, then the proposed combination fails to meet the claim recitations, because folders such as the “inbox” and “sent items” are the places that the e-mails are extracted from in Tafoya, not the place where the e-mail addresses are added. If folders such as “inbox” in Tafoya are being used by the Office as the “electronic address book”, then the proposed combination fails to meet many recitations in Claim 1, such as, “automatically adding the e-mail address to the electronic address book in a priority order based on the first defined criterion if the first defined criterion is satisfied”. In Tafoya, folders such as “inbox” are one place where emails are extracted from, and the extraction is used to generate a resolution list.

If the Office is using the “resolution list” of Tafoya as the electronic address book, then the rejection and the proposed combination of Tafoya and Huang makes no sense. It does not make sense to use folders such as a my-HOTMAIL folder, a my-AOL folder, etc., as folders within the resolution list of Tafoya since those are folders in which e-mails are stored, not resolution lists.

The main problem seems to be that the Office appears to be treating folders such as “inbox” and “sent items” and “my-HOTMAIL folder” as if they were the same thing as a resolution list, which they are not.

Second, it is respectfully submitted that the rejection to Claim 1 should be withdrawn at least because the Office has failed to make a prima facie case that Tafoya or Huang, singly or in

combination, disclose or teach the recitation, “to receive a first defined criteria communicated over the network from a client browser during a communication session with the first application”, as recited in Applicants’ Claim 1. The Office claims that this recitation is disclosed at col. 10, lines 54-55 of Tafoya, “the criteria used to determine whether or not an entry should be added to the resolution list”. However, this says nothing about receiving the criteria over a network.

It is respectfully submitted that the rejections to Claims 9, 16, 18, 21, and 28 should be withdrawn at least for reasons similar to those stated above with regard to Claim 1.

It is respectfully submitted that the rejection of Claims 2-8 under 35 U.S.C. § 103 should be withdrawn at least because they depend from Claim 1. It is respectfully submitted that the rejection of Claims 10-15 under 35 U.S.C. § 103 should be withdrawn at least because they depend from Claim 9. It is respectfully submitted that the rejection of Claim 17 under 35 U.S.C. § 103 should be withdrawn at least because it depends from Claim 16. It is respectfully submitted that the rejection of Claims 19 and 20 under 35 U.S.C. § 103 should be withdrawn at least because they depend from Claim 18. It is respectfully submitted that the rejection of Claims 22-25 under 35 U.S.C. § 103 should be withdrawn at least because they depend from Claim 21. It is respectfully submitted that the rejection of Claim 29 under 35 U.S.C. § 103 should be withdrawn at least because it depends from Claim 28.

Discussion of Comments in Advisory Action regarding 35 U.S.C. § 103

The Advisory Action states, “Applicant argues that the combination of Tafoya and Huang is improper” and that “there is no suggestion to combine the references”. This is not correct. Applicant argued that Tafoya and Huang, singly or in combination, fail to teach all of the claim limitations; Applicant did not argue that the combination is improper, or that there is no suggestion to combine the references.

The Advisory Action also argues that the test of obviousness is not bodily incorporation, but rather what the combined teaching of references would have suggested to those of ordinary skill in the art. But Applicant does not argue bodily incorporation, but rather argues that the combined teachings of the prior art do not teach all of the claim recitations, and do not even make a prima facie case of obviousness. Essentially, the Office attempted to make a hindsight reconstruction of

the claimed invention, but appears to be treating folders such as “inbox” and “sent items” and “my-HOTMAIL folder” as if they were the same thing as a “resolution list” in order to attempt to complete a hindsight reconstruction of the claim elements. However, they are not the same thing, and accordingly the combined teachings of Tafoya and Huang do not suggest “automatically adding the e-mail address to the electronic address book in a priority order based on the first defined criterion if the first defined criterion is satisfied”.

CONCLUSION

It is respectfully submitted that each of the presently pending claims (Claims 1-25 and 28-29) is in condition for allowance and notification to that effect is requested. Examiner is invited to contact the Applicants’ representative at the below-listed telephone number if it is believed that the prosecution of this application may be assisted thereby. Although only certain arguments regarding patentability are set forth herein, there may be other arguments and reasons why the claimed invention is patentable. Applicant reserves the right to raise these arguments in the future.

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Respectfully submitted,

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